

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/722,158	3/30/04	JAMES W. NORRIS, ET AL.	EH-10676

Title: **PULSED COMBUSTION ENGINE**

Art Unit	Paper Number
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Correspondence Address:

WILLIAM B. SLATE
BACHMAN & LAPOINTE, P.C.
900 CHAPEL STREET
SUITE 1201
NEW HAVEN, CT. 06510

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 535,501

Grant Date: 25-Nov-05

This license is granted retroactively to the date(s) and the country(s) indicated on the attached decision.

Approved:


for Commissioner of Patents and Trademark

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license does not empower the filing of any applications, amendments, supplements or continuances originating in this country which disclose inventions, modifications, or variations not disclosed in the subject matter identified above.

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Office of Foreign Assets Control, Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

William B. Slate
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NEW HAVEN CT 06510

In re: Norris et al : DECISION ON REQUEST
Serial No.: 10/722,158 : UNDER 37 CFR 5.25
Filing date: 24 November 2003
Docket No: EH-10678

Title: PULSED COMBUSTION ENGINE

In view of the communication(s) filed 28 February 2005, it has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R. 5.11 first having been obtained through error and without deceptive intent.

Country

Date

Europe

24 December 2003

Approved:

Andrea M. Valenti
Patent Examiner
Group 3643
(571)272-6895

09 November 2005

BACHMAN & LaPOINTE, P.C.

REGISTERED PATENT ATTORNEYS

SPECIALIZING IN INTELLECTUAL PROPERTY

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(203) 789-0582TELECOPIER COVER LETTERTo: Licensing and ReviewFrom: William B. SlateFAX #: 703-305-7658Date: February 28, 2005Your Ref.: SN 10/722,158Our Ref.: EH-10676 (02-647)Number of Pages including this sheet: 8Confirmation Copy to Follow: Yes XX No

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* Comments:

FEB 28 2005

LICENSING & REVIEW

I hereby certify that this correspondence is being faxed this 28th day of February, 2005 to the USPTO, at Fax No. 1-703-305-7658.


Antoinette Sullo

Please acknowledge receipt of this letter by email, telephone, telefax or telex and advise us if any pages are not readily legible or have not been received.

The information contained in this communication is confidential, may be attorney-client privileged, may constitute inside information, and is intended only for the use of the addressee. Unauthorized use, disclosure or copying is strictly prohibited and may be unlawful. If you have received this communication in error, please notify us immediately and destroy this transmittal.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : JAMES W. NORRIS ET AL.
Confirmation No.: 6770
Serial No. : 10/722,158
Filed : November 24, 2003
TC/A.U. : 3746
Examiner :

Docket No. : EH-10676 (02-647)
Customer No. : 34704

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

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LICENSING DIVISION

RENEWED PETITION AND REQUEST FOR FURTHER CONSIDERATION OF
DECISION

Sir:

This is a request for reconsideration or further consideration of the Decision mailed February 11, 2005 regarding the Petition for Retroactive License. Enclosed is a Renewed/Revised Petition.

The Decision identified two issues. First, the Decision asserted that the requirements set forth in 37 CFR 5.25(a)(3)(iii) had not been met. The Renewed/Revised Petition contains further statements in this regard. Specifically, the undersigned had assumed that foreign filing would be by means of International Application filed through the RO/US for which no foreign filing license is required. When presented with an unexpected decision to file EP, the undersigned through error and without deceptive intent failed to reconsider the foreign filing license issue.

Second, the decision identifies an asserted date discrepancy between the first paragraph date of November 24, 2003 and the second paragraph date of December 24, 2003. The apparent discrepancy is explained as follows. The former date is the date of US filing. The latter date is the date of EP filing. Because, as noted in the Petition, communication of the subject matter intervened between those two dates, it was believed appropriate to request the license be retroactive to the earlier date. If, however, the Patent and Trademark Office believes the latter date or another date is effective to provide the relief requested, such a date would be appropriate.

Respectfully submitted,

JAMES W. NORRIS ET AL.

By 

William B. Slate

Attorney for Applicants

Reg. No. 37,238

Tel: (203) 777-6628

Fax: (203) 865-0297

Date: February 28, 2005

I hereby certify that this correspondence is being faxed this 28 day of February, 2005 to the USPTO, Attn: Licensing and Review, at Fax No. 1-703-305-7658.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : JAMES W. NORRIS ET AL.
Confirmation No.: 6770
Serial No. : 10/722,158
Filed : November 24, 2003
TC/A.U. : 3746
Examiner :

Docket No. : EH-10676 (02-647)
Customer No. : 34704

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

RENEWED/REVISED PETITION UNDER 37 C.F.R. 5.25 AND 35 U.S.C. 184

Sir:

Applicant petitions that the foreign filing license granted February 26, 2004 for the patent application material disclosed in the above-identified '158 application be made retroactive to November 24, 2003 (or to December 24, 2003 or otherwise as may be sufficient) to avoid abandonment of the above-identified application.

As required in 37 C.F.R. 5.25(a)(1) and (2) the undersigned lists that unlicensed patent material was filed in the European Patent Office (EP) on December 24, 2003 as Ser No 0325851.4 under circumstances discussed in further detail below.

As required by 37 C.F.R. 5.25(a)(3) the undersigned hereby declares as follows:

The subject matter in question was not under a secrecy order at the time it was filed abroad and is not currently under a secrecy order.

Ser. No. 10/722,158

The license has been diligently sought after discovery of the prescribed foreign filing in that the prescribed nature of the foreign filing was realized in the afternoon of March 4, 2004. The undersigned had received and reviewed the filing receipt in the '158 application earlier that morning. In the afternoon, in the course of reviewing unrelated material, the undersigned encountered a discussion of foreign filing licenses and had a lightning bolt-like realization that there may have been problems with the above-identified application. The undersigned that day took prompt action to investigate the relevant statutory and regulatory provisions and begin to prepare the present petition.

The material was filed abroad through error and without deceptive intent without the required license under 37 C.F.R. 5.11 first having been obtained. The circumstances of such filing relate to the filing of the above-identified application and three other applications in related technology. The four applications are:

Serial Number	Filing Date
10/334,019	December 30, 2002
10/608,238	June 27, 2003
10/608,939	June 26, 2003
10/722,158	November 24, 2003

The first-filed '019 application has claims broadly directed to techniques for initiating deflagration-type combustion and specifically directed to use of those techniques in hybrid gas turbine engines with a particular embodiment of a gas turbine engine illustrated. The '019 case is not under secrecy order and six months had past from the time of its filing well before the foreign filing process discussed below began.

Ser. No. 10/722,158

The basic structure of the hybrid engine embodiment shown in the '019 application had previously been identified for use with detonation-type combustion in an invention disclosure (an internal corporate document). Earlier structures utilizing the basic principles had been yet previously identified in other invention disclosures. Greatest filing priority, however, had been given to the deflagration-related disclosure which gave rise to the '019 application thus causing that disclosure to be filed prior to filing on earlier-envisioned disclosure.

Accordingly, the '238 application was later filed with claims directed to the basic principles common to the previous invention disclosures and the illustrated embodiment of the '019 application. The principal illustrated embodiment was, thus, nearly identical to that of the '019 application. An alternate embodiment from one of the yet-previous invention disclosures was also included as Figure 10. The '238 application was made a Continuation-in-Part of the '019 application. A separate petition is being submitted regarding the '238 application.

The '939 application was prepared roughly simultaneously with the '238 application. The '939 application is directed to a hybrid gas turbine engine having an alternate combustor structure to the exemplary embodiments of the '019 and '238 applications. A foreign filing license was granted in that case on September 12, 2003. Accordingly, no petition regarding foreign filing of that case is believed to be presently required.

The '158 application is directed to a sealing system for combustor carousels of hybrid engines such as those in the '019 and '238 applications. Certain features of the '158 application are clearly disclosed in the '019 and '238 applications. However, others, particularly discussions of dimensional ranges are not. As

Ser. No. 10/722,158

with the disclosures that gave rise to the '238 application, the '158 application is based on the disclosure submitted earlier than that of the '019 application but which was assigned a lower priority. It is for this reason that so much of the disclosure of the '158 application was included in the '019 application. Thus it is believed that the "modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181" and thus no additional foreign filing license was required under 37 C.F.R. 5.11 (e) (3) (iii). Nevertheless, this petition is submitted.


As a result of the earliest filing date of the '019 application, it was decided to simultaneously foreign file the '019, '238, and '158 applications to avoid prior art complications abroad. It was later realized that, in addition to the '019, '238, and the '158 applications, the '939 application need to be considered because certain prophetic (non-illustrated) alternate embodiments identified in the earlier applications might cause prior art problems if foreign filing of that case did not occur simultaneously. Convention foreign filing of the '019 patent application had to take place by December 30, 2003.

The undersigned had assumed that foreign filing would be via PCT with the RO/US (in view of the short lead time between the filing of the present application and the planned foreign filing). In such a situation, no foreign filing license would have been required at that point. However, the assignee indicated a desire to file only in the EPO. When the decision was made to file EP instead, we failed to reconsider the foreign filing license implications. After filing the present application, advice from an EP attorney was desired as to the exact priority implications and

Ser. No. 10/722,158

appropriate Paris Convention claims to be made in the EP filings. This advice was sought in early December, 2003, by faxing the four applications to European patent attorney David Leckey on December 3, 2003. At that point, although the '019 application had a foreign filing license under 37 CFR 5.11 (e) (2), the undersigned failed to appreciate that express foreign filing licenses in the other applications had not been granted. As discussed above, it was only after review of the filing receipt on March 4, 2004, that it became appreciated that a foreign filing license was needed in this application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



William B. Slate
Reg. No. 37,238

2/28/05

Date

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/722,158	30-Mar-04	JAMES W. NORRIS, ET AL.	EH-10676

Title: PULSED COMBUSTION ENGINE

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Art Unit	Paper Number
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NEW HAVEN, CT. 06510

PATENT & TRADEMARK OFFICE
MAILED

FEB 11 2005

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

William B. Slate
BACHMAN & LAPOINTE, P.C.
900 CHAPEL STREET
SUITE 1201
NEW HAVEN CT 06510

In re: Norris et al : DECISION ON REQUEST
Serial No.: 10/722,158 : UNDER 37 CFR 5.25
Filing date: 24 November 2003
Docket No: EH-10678

Title: PULSED COMBUSTION ENGINE

This is a decision on the petition filed on 30 March 2004 for a retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(iii) have not been met.

The verified statement appears to have a date discrepancy. The first paragraph on the first page indicates the date of 24 November 2003, but the second paragraph on the first page indicates the date 24 December 2003. It appears that "December" should be --November--? Clarification is requested.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and

in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Andrea M. Valenti
Patent Examiner
Group 3643
(703) 305-3010

21 December 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : JAMES W. NORRIS ET AL.
Confirmation No.: 6770
Serial No. : 10/722,158
Filed : November 24, 2003
TC/A.U. : 3746
Examiner :

Docket No. : EH-10676 (02-647)
Customer No. : 34704

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

PETITION UNDER 37 C.F.R. 5.25 AND 35 U.S.C. 184

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that of the '019 application but which was assigned a lower priority. It is for this reason that so much of the disclosure of the '158 application was included in the '019 application. Thus it is believed that the "modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181" and thus no additional foreign filing license was required under 37 C.F.R. 5.11 (e) (3) (iii). Nevertheless, this petition is submitted.

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The assignee indicated a desire to file in the EPO. Advice from an EP attorney was required as to the exact priority implications and appropriate Paris Convention claims. This advice was sought in early December, 2003, by faxing the four applications to European patent attorney David Leckey on December 3, 2003. At that point, although the '019 application had a foreign filing license under 37 CFR 5.11 (e) (2), the undersigned failed to appreciate that express foreign filing licenses in the other applications had not been granted. As discussed above, it was only after review of the filing receipt on March 4, 2004, that

it became appreciated that a foreign filing license was needed in this application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



William B. Slate

Reg. No. 37,238

3/17/2004

Date